

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EZ NAILS, INC.

Opposer,

v.

Opposition No. _____

Millenia Productions, LLC,

Applicant.

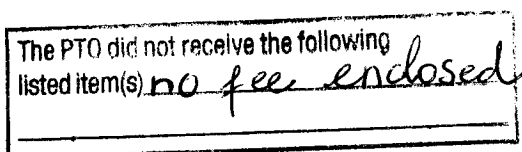
NOTICE OF OPPOSITION

Honorable Commisioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22312-1451

In the matter of the Application of Millenia Productions, LLC (“Applicant”) for registration of the mark Gel II (the “Gel II Mark”), Application Serial No. 85/676,821 (the “Application”), filed July 13, 2012, and published for opposition in the Official Gazzette on December 11, 2012, EZ Nails, Inc., a California Corporation having a place of business at 10540 Ashdale Street, Stanton, CA 90680 (“EZ Nails”), believes that it will be damaged by the registration of the mark shown in the Application and hereby opposes the same. The grounds for the opposition are as follows:

A. Summary of Facts

1. EZ Nails is a California Corporation with its principal place of business at 10540 Ashdale Street, Stanton, CA 90680.
2. Applicant is Kansas Corporation with its principal place of business at 3201 N. Mead, Wichita, KS 67219-4053.
3. EZ Nails is an established company that sells nail products to salons and supply houses.



06-12-2013

EZ Nails has been in business since in or about December 1997.

4. EZ Nails has a superior reputation in its industry and its products are well-known for their quality and value.

5. EZ Nails is the owner of the name and mark “Gella” for gel style nail polish products, and of the following U.S. Trademark Registrations for the mark “Gella” for such products (the “Gella Marks”):

Mark	Goods/Services	Registration No.
Gella	Gel style Nail Polish	4,034,360
Gella	Gel style Nail Polish	4,320,847

6. The registrations for the Gella Marks are valid and subsisting. Copies of the registrations for the Gella Marks are attached hereto as Exhibit A and incorporated herein by this reference.

7. The Gella Marks are inherently distinctive as used with EZ Nails’ goods and services.

8. EZ Nails’ use of the Gella Marks has been continuous and commercially significant for many years in connection with Gel style nail polish and related goods and services.

9. Applicant has filed its application as an intent-to-use application and, thus, has not claimed a first use in commerce date.

10. EZ Nails’ registration 4,034,360 has a first use in commerce date of February 1, 2011 and was registered on October 4, 2012, which dates are prior to the registration date of Applicant’s Gel II Mark herein opposed.

11. EZ Nails registration 4,320,847 has a first use in commerce date of February 1, 2011, which date is prior to the registration date of Applicant’s Gel II Mark opposed herein, and was registered on April 16, 2013.

12. Applicant has sought to register the mark “Gel II” in standard character format for goods,

namely, nail gel in Class 002 pursuant to its intent-to-use application filed on July 13, 2012, Application Serial No. 85/676,821, and published for opposition in the Official Gazette on December 11, 2012 (the “Gel II Mark”).

B. Registration of the Gel II Mark Should be Denied on the Grounds that it is Confusingly

Similar to the Gella Marks Pursuant to 15 U.S.C. §1052(d)

13. EZ Nails incorporates herein by this reference paragraphs 1 through 12 described above.

14. Pursuant to 15 U.S.C §1052(d), a mark that is confusingly similar to another mark, whether registered in the United States Patent and Trademark Office or used in the United States, is not entitled to federal registration on the Principal Register.

15. In or about May 2012, EZ Nails contacted Applicant and demanded it cease and desist use of a Gel II mark, serial number 85,535,597, (the “597 Mark”) on the grounds that it was confusingly similar to EZ Nails’ Gella Marks.

16. From in or about May 2012 until September 2012, EZ Nails and Applicant had numerous correspondence regarding the 597 Mark and the claims by EZ Nails that the 597 Mark was confusingly similar to EZ Nails’ Gella Marks.

17. On or about September 27, 2012, Applicant expressly abandoned the 597 Mark in response to EZ Nails’ demands.

18. After expressly abandoning the 597 Mark, Applicant filed an intent-to-use application for the Gel II Mark.

19. Notwithstanding that Applicant filed its application for the Gel II Mark as an intent-to-use mark, EZ Nails is informed and believes that Applicant has been using the Gel II Mark in commerce since in or about September 2012 as evidenced by the screen shot dated October 5, 2012 from the website located at www.geltwo.com which is attached hereto as Exhibit B and incorporated herein by this reference.

20. Because of EZ Nails' substantial investment of time and resources nationally to promote, advertise and enforce its Gella Marks, consumers have come to associate the Gella Marks with EZ Nails' goods and services.

21. By virtue of EZ Nails' continuous use in commerce of its Gella Marks in connection with Gel style nail polish and related goods, such products and business have become favorably and prominently known to the relevant trade and public under such marks.

22. EZ Nails' Gella Marks are valid, and have been valid and in continuous use since at least the dates of first use and have not been abandoned.

23. EZ Nails is informed and believes that Applicant is using its Gel II Mark for the sale of Gel style nail polish (see Exhibit B attached hereto)

24. EZ Nails has, on numerous occasions, demanded that Applicant cease and desist use of the Gel II Mark on the grounds that it is confusingly similar to the Gella Marks in appearance, sound and connotation.

25. Here, the Gel II Mark uses a script that is confusingly similar to the script used in the Gella Marks. Accordingly, Applicant's Gel II mark is likely to cause confusion, mistake and/or deception with the Gella Marks.

26. Upon information and belief, Applicant's Gel style nail polish is marketed and sold, or intended to be marketed and sold, under the Gel II Mark, to the trade and general public, which is the same market for the Gella Marks.

27. In the Application, there are no restrictions on trade channels, so it must be presumed that the goods identified in the Application will travel through all trade channels appropriate for goods of that type.

28. On information and belief, Applicant's goods are marketed through channels of trade that overlap with the channels of trade in which EZ Nails' products are marketed, and Applicant's intended class of purchasers directly overlaps with the classes of purchasers to which EZ Nails

markets its products.

29. After numerous demands by EZ Nails, Applicant, on or about January 31, 2013, added the word “manicure” to its Gel II Mark as evidenced by the screen shot from Applicant’s website www.geltwo.com, a copy of which is attached hereto as Exhibit D and incorporated herein by this reference. The Applicant however, is currently using in commerce the Gel II Mark with the word “manicure” as part of the mark.

30. EZ Nails is informed and believes that Applicant added the word “manicure” to the Gel II Mark in response to EZ Nails’ demands that its Gel II Mark is confusingly similar to the Gella Marks.

31. If Applicant were permitted to register its Gel II Mark as evidenced in the Application for goods, namely nail gel, in Class 003, confusion of the relevant trade and public is likely to result, which will damage and injure EZ Nails.

C. Registration of the Gel II Mark Should be Denied as it is Descriptive

Pursuant to 15 U.S.C. §1052(e)

32. Paragraphs 1 through 12 are incorporated herein by this reference.

33. EZ Nails is informed and believes that Applicant’s proposed Gel II Mark is descriptive and opposes registration on this ground.

34. Under 15 U.S.C. §1052(e), a mark is not entitled to registration if such a mark is merely descriptive of the goods of an applicant.

35. Applicant is seeking to register its Gel II Mark in Class 003 and describes the goods as “nail gel”

36. Since the product to be sold is a “gel” product and the word “gel” is the significant and dominant feature of Applicant’s Gel II Mark, registration of such mark should be denied on the grounds that it is merely descriptive.

37. EZ Nails is informed and believes that the word “gel” is a term well known in the markets and trade channels where nail products are sold in, and that when a potential consumer sees the Gel II Mark such purchaser will know that the product sold under the Gel II Mark is a nail gel product.

38. EZ Nails does acknowledge that Applicant has disclaimed the right to use the word “gel” apart from the mark shown in Applicant’s application. However, despite such disclaimer, EZ Nails is informed and believes that the Applicant’s Gel II mark is a descriptive mark as it describes the goods sold under the mark – nail gel.

39. Here, EZ Nails believes that the addition of the word “II” to the word “Gel” is not sufficient to overcome the fact that the Gel II Mark is descriptive of the goods, namely nail gel, sold under the Gel II Mark.

40. Further, EZ Nails does not believe that seeking to register the Gel II Mark in script form is sufficient to overcome the fact that the mark describes that nail gel products are sold under the mark.

41. EZ Nails request that Applicant’s registration be denied on the ground that its Gel II Mark is descriptive of the Applicant’s goods sold under the mark - nail gel.

D. Registration of the Gel II Mark Should be Denied on the Grounds That

It Has Been Materially Altered Pursuant to TMEP §807.14(a)

42. Paragraphs 1 through 12 are incorporated herein by this reference.

43. The Applicant’s Gel II Mark is comprised of the word “Gel” and the word “II”.

44. The Applicant however, is currently using in commerce the Gel II Mark with the word “manicure” as part of the mark. A copy of a screenshot dated June 4, 2013 from the website www.geltwo.com, which shows the mark using the words “Gel” and “II” and “manicure” is attached hereto as Exhibit C and incorporated herein by this reference.

45. Pursuant to TMEP_§807.14(a), the Gel II Mark should not be registered as the addition of the word “manicure” materially alters the mark.

46. Here, EZ Nails questions, as this board should, why Applicant has not proposed to amend its application to add the word “manicure” to its Gel II Mark as it is currently using such amended mark in commerce (see Exhibit C attached hereto).

47. Further, EZ Nails questions, as this board should, how Applicant will be able to prove use in commerce of the Gel II Mark filed under its Application when such mark has been materially altered to include the word “manicure” (see Exhibit C attached hereto).

E. Conclusion

48. If Applicant is granted a registration for the Gel II Mark herein opposed, it would obtain thereby at least a prima facie exclusive right to use the Gel II Mark. Such registration would be a source of damage and injury to EZ Nails.

WHEREFORE, EZ Nails, Inc. prays that registration of the mark of Application Serial No. 85,676,821 in International Class 03 be refused and that this Opposition be sustained.

Dated: June 7, 2013

Respectfully Submitted,

By: 

Jeffrey M. Resnick

Vogt, Resnick & Sherak, LLP
4400 MacArthur Blvd, Suite 900
Newport Beach, CA 92660
(949) 836-9002
(949) 833-3445 fax
jresnick@vrslaw.net

Attorneys for Opposer

Certificate of Service

I, Ann Ha, hereby certify that on today's date, I caused copies of the foregoing notice of opposition to be served by United States First Class Mail, postage prepaid, on the Applicant's attorney as set forth below:

Robert Blinn
125 North Market, Suite 1100
Wichita, Kansas 67202-1711
Phone (316) 263-6400
Fax (213) 263-5491
Email: rblinn@robertblinn.com

Dated: June 7, 2013


By: 
Ann Ha

Exhibit A

United States of America
United States Patent and Trademark Office

GELLA

Reg. No. 4,034,360

Registered Oct. 4, 2011

Int. Cl.: 3

TRADEMARK

PRINCIPAL REGISTER

EZ NAILS, INC. (CALIFORNIA CORPORATION)

11652 MONARCH STREET

GARDEN GROVE, CA 92841

FOR: NAIL POLISH, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 2-1-2011; IN COMMERCE 2-1-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-242,918, FILED 2-15-2011.

WON TEAK OH, EXAMINING ATTORNEY



David J. Kyros

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

Gella

Reg. No. 4,320,847

Registered Apr. 16, 2013

Int. Cl.: 3

TRADEMARK

PRINCIPAL REGISTER

EZ NAILS, INC. (CALIFORNIA CORPORATION)
10540 ASHDALE STREET
STANTON, CA 90680

FOR: NAIL POLISH, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 2-1-2011; IN COMMERCE 2-1-2011.

OWNER OF U.S. REG. NO. 4,034,360.

THE MARK CONSISTS OF THE WORD "GELLA" IN SCRIPT FORM.

SER. NO. 85-709,375, FILED 8-21-2012.

MARTHA FROMM, EXAMINING ATTORNEY



Lisa Street Lee
Acting Director of the United States Patent and Trademark Office

Exhibit B

HOME
ABOUT GEL II
THE PROCESS
TRY ON
COLORS
VIDEOS
TESTIMONIALS
F.A.Q'S
DISTRIBUTORS
BUY GEL II
CONTACT US



Exhibit C

©2013 La Palm Products®. All Rights Reserved.